UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,623	09/16/2005	Toshiyasu Yabe	9683/216	2703

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EXAMINER
KIM, HEE SOO

ART UNIT	PAPER NUMBER
2157	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *27 March 2008*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-14* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to application filed on March 27th, 2008.

Response to Amendment

Claim 1 was amended to correct a misspelled word. The objection is now withdrawn.

Claims 2, 7, and 12 have been cancelled.

Claims 13 and 14 have been newly added.

Therefore, claims 1, 3~6, 8~11, 13, and 14 are pending examination.

Response to Arguments

Applicant's arguments with respect to claims 1, 3~6, 8~11, 13, and 14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1~3, 5, 6, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyda et al. hereinafter Beyda (US 6,275,850).

Regarding Claim 1,
Beyda taught an e-mail distribution method for sending e-mail with attachment files from a server apparatus to a communications terminal, the method comprising:

an obtaining step of obtaining type information that identifies a type of an attachment file that a user of the communications terminal desires to receive (Col. 5, Ln. 11~14, Col. 6, Ln. 50~62),

a storing step of storing the type information in a memory of the communications terminal (Col. 2, Ln. 46~49, attachment filter is computer program which is stored in memory);

a generating step of generating, by the communication terminal upon receipt of an arrival notice from the server apparatus, a request for obtaining e-mail destined for the communications terminal, the request including data indicating the type information stored in the memory (Col. 4, Ln 36~45, client devices are configured to automatically download attached files (request is made for download) only if the attributes of the email messages and their attachments satisfy a prescribed requirement);

a sending step of sending the request that includes the data indicating the type information to said server apparatus from the communications terminal (Col. 3, Ln 4~13);

a receiving step of receiving the type information in the server apparatus (Col. 4, Ln 50~51);

a step of determining, upon receipt of the request at the server apparatus, whether a type of an attachment file of e-mail, which is destined for the communications terminal and received by the server apparatus, is identical to a type identified by the type information (Col. 7, Ln 23~29), and

a step of sending from the server apparatus to the communications terminal e-mail from which the attachment file is deleted, when the type of the attachment file of the e-mail is not identical to the type identified by the type information, and transferring the e-mail from the server apparatus to the communications terminal, when the type of the attachment file of the e-mail is identical to the type identified by the type information (Col. 7, Ln 23~39).

Regarding Claims 3 and 8,
Beyda taught where in said obtaining step the communications terminal displays types of available files used in the communications terminal (Col. 7, Ln 29~30).

Regarding Claims 5 and 10,
Beyda taught information for identifying a type of attachment file which the user doesn't desire to receive is first obtained and then the type information is generated on the basis of information thus obtained (Col. 6, Ln. 50~62).

Regarding Claim 6,
Beyda further taught a communications terminal comprising:

an obtaining means for obtaining type information that identifies a type of an attachment file which a user of the communications terminal desires to receive (Col. 5, Ln. 11~14, Col. 6, Ln. 50~62);

a memory that stores the obtained type information (Col. 2, Ln. 46~49, attachment filter is computer program which is stored in memory);

a generating means for generating, upon receipt of an arrival notice from the server apparatus, a request for obtaining e-mail destined for the communications terminal, the request including data indicating the type information stored in the memory (Col. 4, Ln 36~45, client devices are configured to automatically download attached files

(request is made for download) only if the attributes of the email messages and their

attachments satisfy a prescribed requirement);

a transmitting means for transmitting the generated request that includes the

data indicating the type information to a server apparatus (Col. 3, Ln 4~13); and

a receiving means for receiving an e-mail from the server apparatus (Col. 7, Ln

23~39).

Regarding Claim 11,
Beyda further taught a server apparatus comprising:

means for transmitting an arrival notice to a communications terminal upon

receipt of an email destined for the communications terminal (Col. 4, Ln 36~45);

means for receiving from a communications terminal a request requesting an e-

mail destined for the communications terminal, the request including data indicating

type information that identifies a type of an attachment file a user of the communications

terminal desires to receive (Col. 4, Ln 36~45, client devices are configured to

automatically download attached files (request is made for download) only if the

attributes of the email messages and their attachments satisfy a prescribed

requirement);

means for determining whether a type of an attachment file of the e-mail, which is

destined for the communications terminal and received by the server apparatus, is

identical to a type extracted from the information indicating the type information (Col. 7,

Ln 23~29); and

means for sending to the communications terminal e-mail from which the

attachment file is deleted, when the type of the attachment file of the e-mail is not

identical to the type identified by the type information, and transferring the e-mail to the

communications terminal, when the type of the attachment file of the e-mail is identical

to the type identified by the type information (Col. 7, Ln 23~39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beyda (US 6,275,850).

<u>Regarding Claims 4 and 9</u>,
Beyda taught a storing step of receiving at the communications terminal e-mail

transmitted in said sending step and storing the attachment file of the received e-mail in

said memory (Col. 5, Lines 1~14, the attachment filter determine which attached files

are to be downloaded from the local server <u>to the memory</u> of the client device), however

did not specifically teach the communications terminal further includes detachable memory.

Beyda taught the memory are functionally equivalent to conventional components that are commonly found in other electronic devices (Col. 5, Lines 6~8). Although the memory isn't detachable, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to substitute, the memory of Beyda's with a detachable memory well-known in the art (i.e. flash), allowing e-mails to be saved and transported from one terminal to another.

Regarding Claims 13 and 14,
Beyda taught substantially all the limitations of claims 1 and 6, however did not specifically teach the request complies with GET method of HTTP and includes a CGI parameter representative of an extension of an attachment file which the user of the communications terminal wishes to receive.

Although the attachment filter is a computer program functioned to screen the attachments a user wishes to receive, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify, Beyda's attachment filter to utilize the GET method of HTTP which includes CGI script, since it was well-known in the art using CGI allows a user to command a target server to carry out user-specified operations (i.e. indicating an extension of an attachment file user wishes to receive).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hee Soo Kim whose telephone number is (571) 270-3229. The examiner can normally be reached on Monday - Friday 7:30AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (571) 272-5026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. K./
6/24/08

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157